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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/335,201	06/17/1999	DAVID W. HILL	RP9-99-082	6196
25299	7590	03/23/2004		
IBM CORPORATION PO BOX 12195 DEPT 9CCA, BLDG 002 RESEARCH TRIANGLE PARK, NC 27709			EXAMINER VORTMAN, ANATOLY	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/335,201

Applicant(s)

HILL ET AL.

Examiner

Anatoly Vortman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by
US/2002/0054024 to Andres et al., (Andres).

Regarding claim 1, Andres disclosed (Fig. 2) a PC accessory unit (20) for use with a desktop personal computer assembly including a PC keyboard (18), the PC keyboard (18) being a stand alone component, the PC accessory unit (20) comprising: a body structure incorporating electronic circuitry (Fig. 10, elements (80, 90, 92); column 9, paragraph [0086]) for operation with a PC; and a connecting assembly (Fig. 6-8) coupled to the body structure for attaching the body structure externally to the PC keyboard (Fig. 2).

Regarding claims 2 and 3, Andres disclosed (Fig. 6-8) that the connecting assembly is a clip (52) for attaching to a PC keyboard (18), wherein said clip has two prongs (50,62) for insertion into opening (28) in a PC keyboard (18) (Fig. 4).

Regarding claim 4, Andres disclosed that said accessory unit is a Smartcard utility kit (column 3, paragraphs [0028] and [0029]; column 9, paragraph [0089]).

Regarding claim 5, Andres disclosed that the clip (52) of the Smartcard utility kit is inserted into keyboard opening (28) (Fig. 4).

Regarding claim 6, Andres disclosed (Fig. 2) a PC accessory unit (20) for use with a stand alone keyboard (18), comprising:

a body structure incorporating an electronic circuitry (Fig. 10, elements (80, 90, 92); column 9, paragraph [0086]) for operation with a PC; a connecting assembly (Fig. 6-8) coupled to the body structure; wherein the connecting assembly is coupled externally to the keyboard ((Fig. 4); column 7, lines 1+).

Regarding claim 7, Andres disclosed that the body structure is a Smartcard utility kit (column 3, paragraphs [0028] and [0029]; column 9, paragraph [0089]).

Regarding claim 8, Andres disclosed that said connecting assembly is a clip (52) (Fig. 6-8).

Regarding claims 11 and 12, Andres disclosed (Fig. 4) that the keyboard (18) has a plurality of openings (28, 38, 48), wherein at least one opening (28) is located on the backside of the keyboard (18) for receiving a clip (52), the backside being a surface facing away from a user (Fig. 2).

Regarding claim 9, Andres disclosed (Fig. 2) a PC accessory unit (20), comprising: a body structure incorporating electronic circuitry (Fig. 10, elements (80, 90, 92); column 9, paragraph [0086]) for operation with a PC; a connecting assembly (Fig. 6-8) including a clip (52) coupled to the body structure; and a keyboard (18) having a backside surface (Fig. 4) facing

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away from a user, the keyboard (18) configured to receive the connecting assembly (Fig. 6-8) and clip (52) at the backside of the keyboard (18) (Fig. 2, 4), the keyboard (18) being a stand alone component.

Regarding claim 10, Andres disclosed (Fig. 2) a PC accessory unit (20), comprising: a body structure for holding a device for use with a PC; a connecting assembly (Fig. 6-8) including a clip (52) coupled to the body structure; and a keyboard (18) having a backside surface (Fig. 4) facing away from a user, the keyboard (18) configured to receive the connecting assembly (Fig. 6-8) and clip (52) at the backside of the keyboard (18) (Fig. 2, 4), such that the body structure is attached externally with the backside of the keyboard (Fig. 2), the keyboard (18) being a stand alone component.

3. The Examiner would like to direct the Applicant's attention to the fact that the most pertinent reference applied in the rejection above (i.e. Andres ('024)) may be antedated by a 37 CFR 1.131 affidavit or declaration. Hence, in order to back up the preceding rejection, the following alternative rejection based on the best other art (US/5,268,675) is following (see MPEP § 706.02):

4. Claims 1-3 and 6, are rejected under 35 U.S.C. 102(b) as being anticipated by US/5,268,675 to Garthwaite et al. (Garthwaite).

Regarding claim 1, Garthwaite disclosed (Fig. 2-6) a PC accessory unit (10) for use with a desktop personal computer assembly (Fig. 1) including a PC keyboard (3), the PC keyboard (3) being a stand alone component, the PC accessory unit (10) comprising: a body structure (14, 16) incorporating electronic circuitry (13) for operation with a PC; and a connecting assembly (30)

coupled to the body structure (14, 16) for attaching the body structure (14, 16) externally to the PC keyboard (3) (Fig. 6A-7C).

Regarding claims 2 and 3, Garthwaite disclosed that the connecting assembly (30) is a clip (32, 40, 66) for attaching to a PC keyboard (3), wherein said clip has two prongs (40) for insertion into openings in a PC keyboard (3) (Fig. 6B).

Regarding claim 6, Garthwaite disclosed (Fig. 2-6) a PC accessory unit (10) for use with a stand alone keyboard (3), comprising: a body structure (14, 16) incorporating electronic circuitry (13) for operation with a PC; a connecting assembly (30) coupled to the body structure (14, 16); wherein the connecting assembly (30) is coupled externally to the keyboard (3) (Fig. 6A-7C).

5. Claims 4, 5, and 7-12 are not anticipated by Garthwaite ('675), because Garthwaite did not disclose "a Smartcard utility kit" (claims 4, 5, 7, 8, 11, and 12), and "the keyboard configured to receive the connecting assembly and clip at the backside of the keyboard" (claims 9 and 10).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

US/5828034 and 6312175 disclosed stand alone computer keyboards having attached accessory units.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 571-272-2047. The examiner can normally be reached on Monday-Friday, between 10:00 am and 6:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 571-272-2800, ext 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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A.V.

